

APPLICANT(S): SHILOH, Dekel
SERIAL NO.: 09/814,451
FILED: March 22, 2001
DOCKET NO. P-6217-US
Page 2

REMARKS

The present Response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicant asserts that the present invention is new, non-obvious and useful. Prompt and favorable reconsideration of the Remarks and allowance of the pending claims are respectfully requested.

Status of Claims

Claims 1-20 are pending in the application. Claims 1-20 have been rejected.

Interview Summary

Applicant would like to thank the Examiner for the courtesy of a telephone Interview on February 24, 2004. In the Interview, the Examiner's specific rejections and were discussed, and distinctions between the cited prior art and the claims of the present application were analyzed. Applicant pointed out to the Examiner that certain grounds for rejection and specific statements in the Office Action are not consistent with Applicant's reading of the prior art and the claims. The Examiner suggested that Applicant relate to all the issues discussed in the written Response, and indicated that the contested issues will be considered in light of Applicants arguments.

CLAIM REJECTIONS

35 U.S.C. § 103 Rejections

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Fortenberry et al. (U.S. Patent No. 6,005,939).

With regard to method claims 1-5, the Examiner contended that Fortenberry teaches all the elements recited in these claims, except that Fortenberry fails to disclose a second database that is not linked to the first database. The Examiner further contended that the

APPLICANT(S): SHILOH, Dekel
SERIAL NO.: 09/814,451
FILED: March 22, 2001
DOCKET NO. P-6217-US
Page 3

motivation to have a second database not linked to a first database would have been to allow the system databases not to be interconnected.

A similar rejection was applied to claims 6-20. Out of these claims, claims 12-20 are drawn to a system including the contended first and second database and, therefore, Applicant's arguments are directed to method claims 1-5 as well as to system claims 12-20. However, the rejection based on the alleged teaching of the first and second databases, as outlined above and detailed below, does not appear to be applicable to claims 6-11, which are drawn to a virtual entity, inter alia, because claims 6-11 do not rely on the contested first and second databases. In fact, the virtual entities of claims 6-11 may reside on a single database, as long as the content of the virtual entities is not linkable to the identity of the real users, as further discussed below.

As to claims 6-11, the Examiner seemed to have conceded that Fortenberry fails to teach the "one or more physical attributes" of the virtual entity, as recited in claim 6. However, the Examiner did not indicate if and how this lack of teaching in Fortenberry can be otherwise overcome by the prior art, nor did the Examiner state (or provide any arguments to support a statement) that this feature of claims 6-11 would have been obvious to a person skilled in the art. Therefore, it is respectfully submitted that a prima facie case of obviousness has not been established with regard to claims 6-11 and, thus, the rejection of these claims should be withdrawn at least for this reason. Furthermore, although there are no specific arguments to which Applicant can reasonably respond, it is respectfully submitted that claims 6-11 are patentable over the cited prior art, inter alia, in light of the additional arguments provided below following the discussion of claim 1-5 and 12-20.

In the event that the Examiner believes the rejection of claims 6-11 should be maintained, the Examiner is hereby requested to issue a non-final Office Action, setting forth more clearly the specific grounds for such rejection.

As to the rejection of claims 1-5 and 12-20, Applicant respectfully traverses this rejection at least for the reasons discussed below. First, Applicant disagrees with the Examiner's reading of Fortenberry as disclosing two databases. Second, Applicant disagrees with the way the Examiner characterizes the motivation of the invention to provide two

APPLICANT(S): SHILOH, Dekel
SERIAL NO.: 09/814,451
FILED: March 22, 2001
DOCKET NO. P-6217-US
Page 4

databases that are not linked. Additionally, Applicant submits that the motivation for providing two unlinked databases is not obvious, is not taught or implied by Fortenberry, and cannot be construed based on the teachings of Fortenberry, as discussed in more detail below.

As to the use of two databases, the Examiner seems to draw a parallel between database 214 of Fortenberry and the "first database" recited in independent claims 1, and between passport agent 216 of Fortenberry and the "second database" recited in claim 1. The Examiner bases this analysis on cited portions of Fortenberry, for example, the teaching of the Fortenberry between column 5, line 62 and column 6, line 7.

Applicant respectfully disagrees with the Examiner's analysis. Applicant submits that the cited portions of Fortenberry describe only one database, namely, passport database 214, which the Examiner parallels with the first database of claims 1-5 and 12-20. The Examiner refers to passport agent 216 as a second database; however, in the cited portion of Fortenberry, passport agent 216 is clearly defined as a collective phrase referring collectively to both passport server 212 and passport database 214. Therefore, passport agent 216 contains passport database 214 and does not constitute a separate database, as contended by the Examiner. Without conceding the appropriateness of even characterizing passport agent as a database (since agent 216 includes other components), it is clear that such characterization would be based, at most, on the fact that passport agent 216 includes database passport 214. Therefore, if one were to follow the Examiner's reading of Fortenberry, the first and second databases recited in claims 1 and 12 would be the same component in Fortenberry; namely, passport database 214 would need to be read as being at the same time both the first database and the second databases of claims 1 and 12. It is respectfully submitted that such reading of Fortenberry would not be reasonable.

In view of the above, it is respectfully submitted that Fortenberry does not teach, suggest or imply, at least, using first and second databases, as recited by method claim 1 and system claim 12. Furthermore, the "passport agent" of Fortenberry does not include a first database, which is not accessible from the communication network, and a second database associated with the communication network, wherein the first database includes both real (first) data and virtual (second) data and the wherein the second database includes the virtual (second) data.

APPLICANT(S): SHILOH, Dekel
SERIAL NO.: 09/814,451
FILED: March 22, 2001
DOCKET NO. P-6217-US
Page 5

The passport agent described in Fortenberry includes a database where profiles of many users are saved. However, there is no teaching or suggestion in Fortenberry of storing information of the same user in two separate databases, the first including real and virtual information, and the second including, e.g., only the virtual information, as required by amended claim 1 and 12. Upon reading the particular sections of Fortenberry cited by the Examiner, for example, Col. 5 lines 62-67 and Col. 6 lines 1-7, Applicant could not find a teaching of two databases as recited by claim 1 and 12.

In view of the above, it is respectfully submitted that Fortenberry renders neither claim 1 nor claim 12 obvious. Furthermore, it is respectfully submitted that the structural differences between claims 1 and 12 and Fortenberry are functionally significant in the context of the claimed invention. For example, the two separate databases enable users to interact using exclusively their virtual information, where there is no linkage between the virtual entity and the identity of the real entity, not even through deciphering of encrypted data, e.g., by intentional "hacking" or when there is a failure of the security level being used.

The system described in Fortenberry suggests protecting certain data fields by electronic security means but there is no suggestion in Fortenberry of fundamentally separating real and virtual databases as in claimed invention. The motivation of using two separate databases to provide fundamental separation between the real world and the virtual world cannot be read into the teaching of Fortenberry, inter alia, because Fortenberry is not concerned with such fundamental separation of entities. Therefore, the requirement of separating the first and second databases, in claims 1 and 12, is not obvious in view of the cited prior art.

In view of the above, it is respectfully submitted that independent claims 1 and 12 are patentable over Fortenberry and/or any combination of Fortenberry with other prior art.

As to independent claim 6, first, Applicant would like to point out that the Examiner incorrectly cited a portion of this claim in the Office Action as reading "...information corresponding to a virtual representation..." (emphasis added) when the claim, as previously amended, in fact recites "...information corresponding to a one or more physical attribute of the virtual entity..." (emphasis added). Furthermore, dependent claim 9 recites that the one or more physical attributes includes "a visual representation..."(emphasis added), and not a

APPLICANT(S): SHILOH, Dekel
SERIAL NO.: 09/814,451
FILED: March 22, 2001
DOCKET NO. P-6217-US
Page 6

virtual representation as the Examiner seems to have read the claims prior to the Amendment filed on September 22, 2003. It is respectfully submitted that this apparent typographical error is significant because the one or more physical attributes, which may include, for example, a visual representation or an audio attribute, etc., as disclosed in detail in the specification, provide the virtual entity with content that teaches away from the passport agent described in Fortenberry. Such content of the virtual entity recited in claim 6 cannot be reasonably characterized as a "virtual representation", which the Examiner believes Fortenberry to teach. Applicant asserts that this distinction alone would have been sufficient to overcome the rejection of claim 6 under 35 U.S.C. § 103(a).

Claim 6 recites "one or more physical attributes", which may include a visual representation (e.g., as in dependent claim 9) or other physical attributes of the virtual entity. It is respectfully submitted that there is no such teaching in Fortenberry. Furthermore, in analogy to the above discussion of claims 1 and 12, Fortenberry does not teach or suggest "...wherein said virtual entity is not linkable, on said communication network, to the identity of said real entity", as recited in claim 6. Additionally, in analogy to the above discussion, it is respectfully submitted that the structural differences between claim 6 and Fortenberry are functionally significant in the context of the claimed invention. For example, the virtual entity as defined in claim 6 enables a user to interact using exclusively the virtual entity, where there is no danger of compromising the identity of the real entity, even by intentional "hacking" or when there is a failure of electronic security.

In view of the above, it is respectfully submitted that independent claim 6 is patentable over Fortenberry and/or any combination of this reference with other prior art.

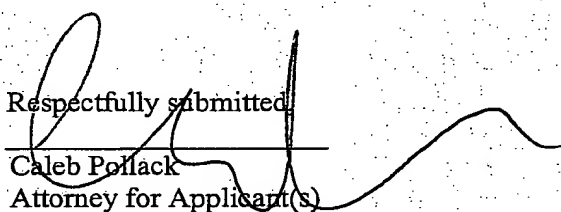
Claims 2-5, 7-11 and 13-20 dependent, directly or indirectly, from independent claims 1, 6 and 12, respectively, and include all the limitations of those claims as well as additional distinguishing features of the invention. Therefore, it is respectfully submitted that claims 2-5, 7-11, and 13-20 are all patentable at least for the reasons discussed above.

APPLICANT(S): SHILOH, Dekel
SERIAL NO.: 09/814,451
FILED: March 22, 2001
DOCKET NO. P-6217-US
Page 7

Conclusion

The present communication is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Prompt and favorable reconsideration and allowance of the pending claims of this application are thus respectfully requested.

Respectfully submitted,


Caleb Pollack
Attorney for Applicant(s)
Registration No. 37,912

Dated: April 5, 2004

Eitan, Pearl, Latzer & Cohen Zedek, LLP.
10 Rockefeller Plaza, Suite 1001
New York, New York 10020
Tel: (212) 632-3480
Fax: (212) 632-3489